



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s): Peter Rae Shintani, et. al.

Filed: 01/02/2001

Serial No.: 09/752,968

Confirmation No.: 1785

Art Unit: 2611

Examiner: Faile, Andrew I.

Docket Number: SNY-P4164

Title: TARGETED ADVERTISING DURING PLAYBACK OF STORED CONTENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

The undersigned submits herewith patents, publications or other information (enclosed herewith and/or listed on the enclosed list of references form) of which he is aware, which he believes is relevant and may be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR §1.56. The order of listing of the references on the attached form and any appendix hereto is without regard for relative relevance to the present invention.

This Information Disclosure Statement is submitted:

☒ Under 37 CFR §1.97(b).

(Within three months of filing national application; or date of entry of international application; or before mailing date of first office action on the merits; whichever occurs last)

☐ Under 37 CFR §1.97(c).

☐ Below is a statement under 37 CFR §1.97(e), or

☐ An IDS submission fee under 37 CFR §1.17(p).

(After the CFR 1.97(b) time period, but before final action or notice of allowance, whichever occurs first. Either a statement under 37 CFR 1.97(e) or an IDS submission fee is required.)

☐ Under 37 CFR §1.97(d).

☐ Below is a statement under 37 CFR §1.97(e), and

☐ Applicant(s) hereby petitions under 37 CFR §1.97(d)(2) for consideration of this Information Disclosure Statement, and

☐ A petition fee set forth in 37 CFR §1.17(i) is paid as indicated below.

(Filed after final action or notice of allowance, whichever occurs first, but before payment of the issue fee)

The undersigned hereby certifies under 37 CFR §1.97(e) that:

- ☐ Each item of information contained in the Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, not more than three months prior to the filing of the statement, or
- ☐ No item of information contained in the Information Disclosure Statement
 - was cited in a communication from a foreign patent office in a counterpart foreign application, and
 - to the knowledge of the undersigned, after making reasonable inquiry, was known to an individual designated in 37 CFR §1.56 (c) more than three months prior to the filing of the Information Disclosure Statement.

A concise explanation of relevance of the items listed on the attached form:

- ☒ Additional information is provided in an appendix to this communication.
- ☐ Appears in the body of the application.
- ☐ Is given for non-English language listed item(s) [Required] and appears in an appendix to this communication.
- ☐ Is in the form of an English language copy of a Search Report (copy attached) from a foreign patent office, issued in a counterpart application which refers to the relevant portions of the references.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR §1.56, this statement does not constitute an admission that any patent, publication or other information referred to therein is "prior art" or "material" to this invention or any application for patent for this invention.

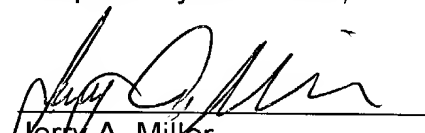
In accordance with 37 CFR §1.97, the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that other information that may be material as defined in 37 CFR §1.56 exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR §1.97 and §1.98 and MPEP §609. The Examiner is requested to fully consider each of these references and acknowledge such consideration by appropriately initialing the attached form and returning a copy to the address below. In addition, the Examiner is requested to conduct a thorough independent search in order to bring the best references available forward in this application.

The fee required for this Information Disclosure Statement is calculated below:

Fee under 37 CFR §1.17(p)	(\$180)	\$
Fee under 37 CFR §1.17(i)	(\$130)	\$
	TOTAL	\$ 0.00

- ☐ A check for the above fees is enclosed.
- ☐ Please the above fees to my credit card. See the enclosed credit card charge authorization form.
- ☒ The commissioner is hereby authorized to charge any additional fees which may be required for this submission, or credit any overpayment to my Deposit Account No. 50-1267.

Respectfully submitted,


Jerry A. Miller
Registration No. 30,779

Dated: 6/14/2004

Please Send Correspondence to:

CUSTOMER NUMBER 24337

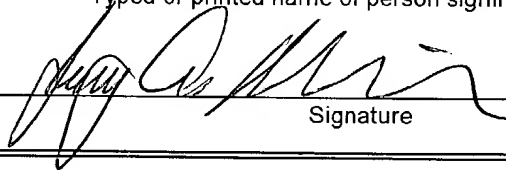
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919)-816-9981
Fax: (919)-816-9982

CERTIFICATE OF MAILING

I hereby certify that this Information Disclosure Statement including associated List of References, Copies of references and fee (if required) is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: 6/14/2004.

JERRY A. MILLER

Typed or printed name of person signing certificate

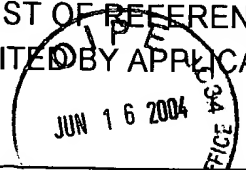

Signature

APPENDIX

Applicants recently became aware, by virtue of the enclosed notification from Special Programs Examiner Bost, that there has been an apparently unsuccessful attempt to file a protest in the present application. This protest was not entered into the files of the USPTO because it apparently did not meet all of the requirements of 37 C.F.R. §1.99 for failure to provide copies and pay the appropriate fee.

Nevertheless, in order to assure that the Examiner considers the very best prior art available during examination of this application, Applicant wishes to bring the contents of the protest and the art referenced in the protest to the attention of the Examiner. Applicant respectfully requests full consideration of the position stated in the protest as well as the art cited in the protest in examination of the present application. Applicant does so without any admission that the art is relevant or material (or more or less relevant than other art) to the patentability of the present invention, or indeed that the listed material in whole or in part even constitutes prior art.

Specifically regarding the reference in the protest to Claria.com web site (formerly Gator.com - which apparently no longer exists - one is directed to Claria.com), Applicant has provided a full printout of all pages of the web site herewith as they existed on June 10, 2004. This printout includes all of the currently available press releases referenced in the web site. However, due to the potential massive volume of printout and uncertain relevance, Applicant has not provided copies of the articles referenced on this web site. The Examiner is encouraged to examine these articles also during examination of this application. A full listing and links to the articles can be found at Claria.com under "company information" > "newsroom" > "articles". Furthermore, while Applicant believes that the attached document represents all information from Claria.com with the exception of the articles from the web site, the Examiner is requested to verify same and explore the actual web site for relevant information in order to assure that the best art is brought forward and considered in examination of this application.

LIST OF REFERENCES CITED BY APPLICANT(S) 	Application No.: 09/752,968	Sheet 1 of 1
	Docket No.: SNY-P4164	Group: 2611
	Filed: 01/02/2001	Conf. No.: 1765
	Applicant: SHINTANI ET. AL.	

U.S. PATENT DOCUMENTS					
Exam. Init.	Document Number	Issue/Pub. Date	Name	Class	Filing Date
	US 6,141,010	10/31/2000	Hoyle		7/17/1998

FOREIGN PATENT DOCUMENTS					
Exam. Init.	Document Number	Date	Country	Class	Translation
	WO9955066 (AKA PCT/US99/08102; CA2328913; EP1076983)	10/28/1999	PCT		N/R

OTHER DOCUMENTS / CITATIONS	
Exam. Init.	Document
	Protest documents dated March 19, 2004 and associated Communication from the USPTO to Applicant regarding the protest
	Clarria.com Web site contents (all contents except referenced articles printed out on 6/10/2004), Press releases individually dated, Claria Corporation, 2003

Examiner:	Date:
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UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 16 2004

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,968	01/02/2001	Peter Rac Shintani	SNY-P4164	1765

24337 7590 05/11/2004

MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH, NC 27606

EXAMINER

FAILE, ANDREW I

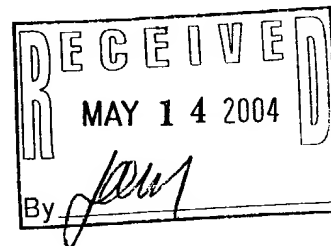
ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 05/11/2004

#13

Please find below and/or attached an Office communication concerning this application or proceeding.





UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
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Paper No. 3

MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH NC 27606

In re Application of)
Peter Shintani, et al.)
Application No. 09/752,968)
Filed: January 02, 2001)
For: TARGETED ADVERTISING DURING)
PLAYBACK OF STORED CONTENT)

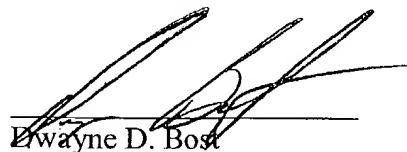
**NOTIFICATION OF
IDENTIFICATION OF PRIOR
ART IN LATE PROTEST UNDER 37
C.F.R. § 1.291(a)**

The protest filed March 26, 2004, is a proper citation under 37 C.F.R. §1.291(a); however it was filed after the September 5, 2002 publication date of the application.

Because the protest was filed after publication of the application it is not being entered in the application file. The original protest is enclosed with this letter and the duplicate copy submitted by the protestor is being destroyed in accordance with MPEP § 1901.06, Protest Filed After Allowance Or The Publication Of The Application.

If appropriate, Applicant may wish to consider submitting prior art from the protest pursuant to 37 C.F.R. §1.97 and 37 C.F.R. §1.56 during the prosecution of the application.

The protest did not satisfy the requirements pursuant to 37 C.F.R. §1.99 for failure to provide copies of the references and failure to pay the appropriate fee.



Ewayne D. Bost
Special Programs Examiner
Technology Center 2600
Communications

Enc: Protest (4 pages)